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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/619,751	07/14/2003	Luke W. Clauson	017-001	7398
32746	7590	01/26/2005	EXAMINER	
HOEKENDIJK & LYNCH, LLP P.O. BOX 4787 BURLINGAME, CA 94011-4787			LEWIS, TISHA D	
			ART UNIT	PAPER NUMBER
			3681	

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/619,751

Applicant(s)

CLAUSON, LUKE W.

Examiner

TISHA D. LEWIS

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17, 19-33, 53-58, 61-66, 86 and 96-120 is/are pending in the application.
- 4a) Of the above claim(s) 22 and 57 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 53-56, 58, 61-66 and 110-120 is/are allowed.
- 6) ☒ Claim(s) 17, 19-21, 23-27, 30, 32, 33, 86 and 96-109 is/are rejected.
- 7) ☒ Claim(s) 28, 29 and 31 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

The following is a first action on the merits of application serial no. 10/619,751 filed on July 14, 2003.

Election/Restrictions

Claims 22 and 57 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on November 12, 2004.

Information Disclosure Statement

The information disclosure statement filed on December 29, 2003 has been acknowledged.

Claim Objections

Claim 32 is objected to because of the following informalities:

-in line 1 before "first", --the-- should be inserted. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 17, 19-21, 23-33 and 96-109 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 17 and 96 recites the limitation "the transmission", "the first motor", and "the output shaft" in lines 1 and 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 17, 19-21, 23-27, 30, 32, 33 and 86 are rejected under 35 U.S.C. 102(e) as being unpatentable by Holmes ('631). As to claims 17, 19 and 86, Holmes discloses a variable transmission having a first motor (60), a second motor (22), an output shaft (connecting shaft 20 outputting to planetary 18), a planetary gear set (16) including a ring gear (30), a sun gear (32), a carrier (36) supporting a planet gear (34), both motors and output shaft being coupled to one of the planetary gears (column 3, lines 24-26), the ratio between the first motor and output shaft is varied by varying the speed of the second motor (reducing the speed of motor 22 to zero then increasing the speed after that), wherein the speed of the output shaft increases when the speed of the second motor increases (when speed of motor 22 increases, the speed of shaft 20 is increased to provide output to the planetary 18 providing the ratio) and the first motor speed is held constant (Figure 3, Nss held constant, IN).

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As to claims 20 and 21, Holmes discloses the first motor being an engine (60) and the second motor being an electric motor (22).

As to claim 23, Holmes discloses the first motor being coupled to the sun gear, the second motor being coupled to the carrier and the output shaft being coupled to the ring gear (Figure 1E).

As to claims 24 and 25, Holmes discloses axially shiftable gears (46-50) for synchronizing rotation between the first motor, second motor and output shaft.

As to claims 26 and 27, Holmes discloses a specified performance range for the first motor to operate.

As to claims 30 and 32, Holmes discloses a motor assisting mode with the engine which combines power before to be sent to the output.

As to claim 33, Holmes discloses the second motor also being a generator to provide electrical energy and a storage device for storing that energy (62).

Allowable Subject Matter

Claims 28, 29 and 31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 96-109 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Claims 53-56, 58, 61-66 and 110-120 are allowed.

The following is an examiner's statement of reasons for allowance: The prior art of record does not disclose or render obvious a motivation to provide for:

-(As to claim 53) a method of combining power of a first and second motor by varying a transmission ratio between the first motor and an output shaft in a first mode of operation by varying the speed of the second motor and synchronizing the rotation between the first and second motors and output shaft in a second mode of operation in combination with all the remaining limitations of claims 53.

-(As to claim 96) a method of varying a transmission ratio between a first motor and an output shaft by varying the speed of a second motor in a first mode of operation and stopping the second motor for a fixed speed ratio between the first motor and output shaft in a second mode of operation in combination with all the remaining limitations of claim 96.

-(As to claim 110) a method of combining power of a first and second motor by varying a transmission ratio between a first motor and an output shaft by varying the speed of a second motor in a first mode of operation and stopping the second motor for a fixed speed ratio between the first motor and output shaft in a second mode of operation in combination with all the remaining limitations of claim 110.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

FACSIMILE TRANSMISSION

Submission of your response by facsimile transmission is encouraged. Group 3600's facsimile number is **(703) 872-9326 before final and 703-872-9327 after final**. Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase a patent's term, it is to your benefit to submit

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responses by facsimile transmission whenever permissible. Such submission will place the response directly in our examining group's hands and will eliminate Post Office processing and delivery time as well as the PTO's mail room processing and delivery time. For a complete list of correspondence not permitted by facsimile transmission, see MPEP 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check should not be submitting by facsimile transmission separately from the check.

Responses submitted by facsimile transmission should include a Certificate of Transmission (MPEP 512). The following is an example of the format the certification might take:

I hereby certify that this correspondence is being facsimile transmitted to
the Patent and Trademark Office (Fax No. (703) 000-0000) on _____ (Date)

Typed or printed name of person signing this certificate:

(Signature)

If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and MPEP 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been transmitted by facsimile will only cause further unnecessary delays in the processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure

-Kojima et al ('134), Xiaolan ('856), Tsuzuki et al ('198), Schmidt ('035), Stemler et al ('410), Minagawa et al ('526), Thomson ('076).


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to TISHA D. LEWIS whose telephone number is 703-305-0921. The examiner can normally be reached on M-Thur 8 AM TO 3 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, CHARLES A. MARMOR can be reached on 703-308-0830. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tdl
January 24, 2005


TISHA LEWIS
PRIMARY EXAMINER
AU 3681 1/24/05